

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) REIIP101USA	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 15, 2009</u> Signature <u>/Christine Gilroy/</u> Typed or printed name <u>Christine Gilroy</u>		Application Number <u>10/797,937</u>	Filed <u>March 11, 2004</u>
		First Named Inventor <u>Avinoam Rubinstain</u>	
		Art Unit <u>2614</u>	Examiner <u>Antim G. Shah</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	<u>/Thomas G. Eschweiler/</u>	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/56)	<u>Signature</u> <u>Thomas G. Eschweiler</u> <u>Typed or printed name</u>	
<input checked="" type="checkbox"/>	attorney or agent of record. <u>36,981</u> Registration number	<u>(216) 502-0600</u> Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34	<u>September 15, 2009</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No. REIP101USA

S2388 GC

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re **PATENT** application of:

Applicant: Avinoam Rubinstein

Serial No.: 10/797,937

For: ETHERNET TRANSPORT OVER A TELEPHONE LINE

Filing Date: March 11, 2004

Examiner: Antim G. Shah

Art Unit: 2614

**PRE-APPEAL REQUEST FOR REVIEW IN RESPONSE TO**  
**ADVISORY ACTION DATED AUGUST 11, 2009**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Favorable reconsideration of the above-identified application is respectfully requested in view of the following remarks.

**REMARKS**

Claims 1-19 are pending in the application. Reconsideration of the application is respectfully requested based on the following remarks.

**I. REJECTION OF CLAIMS 1-5, 8-9 AND 11-19 UNDER 35 U.S.C. § 102(e)**

Claims 1-5, 8-9 and 11-19 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,055,268 (Timm et al.). Withdrawal of the rejection is respectfully requested for at least the following reasons.

- i. Timm et al. do not teach a modem comprising a data collection and reorganization unit that is configured to assemble upstream DSL signals into a single Ethernet signal for transmission, as recited in claims 1, 17 and 19.*

Claim 1 is directed to a modem for bi-directional transport of an Ethernet signal over a configurable number of telephone lines. The modem comprises a data collection and reorganization unit that is ***configured to assemble upstream DSL signals into a single Ethernet signal***. Claims 17 and 19 also recite a data collection and reorganization unit. Timm et al. do not teach this feature.

The gist of applicant's previous argument on pages 9-10 of the response of March 10, 2009, was that the DSL router 330 of Timm et al. does not combine signals received at its ports from the device 340, 342 and 344 into a single Ethernet signal, and thus Timm et al. do not disclose a data collection reorganization unit as claimed. The Office Action of June 15, 2009, disagreed, stating:

Fig. 3b shows "MDSL modem" acting as a router. But it is still a MDSL modem. DSL modems that manage connection with a group of machines are termed as [a] DSL router. But they still have [the] function of performing framing data, segmenting data and reassembling data. Timm discloses MDSL modem that sends and receives the data from MDSL ports and Ethernet ports. ***It is inherent to sequence, split and re-assemble the data frames.*** Thus, Timm discloses

a data collection reorganization unit as claimed in claims 1, 17 and 19. (O.A., 6/15/09, p. 19, paragraph 13)(Emphasis added).

Applicant respectfully disagreed with the above assertion, and submitted arguments in the response dated July 29, 2009, that the assertion that Timm et al. anticipate the pending claims under the doctrine of inherency is incorrect.

An Advisory Action was then received, which stated:

Fig. 3b [of Timm et al.] shows "MDSL modem" acting as a router. But it is still a MDSL modem. DSL modems that manage connection with a group of machines are termed as DSL router. But they still have function of performing framing data, segmenting data and reassembling data.... ***It is inherent to sequence, split and re-assemble the data frames.*** (A.A., 8/11/09, cont. of 11)(Emphasis added).

It is respectfully submitted that Timm et al. do not anticipate the pending claims under the doctrine of inherency for at least the following reasons.

Initially, the principle of anticipation based on inherency is clear. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is ***necessarily present*** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art. Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991)(Emphasis added). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Id. at 1269.

It is respectfully submitted that Timm et al. fail to anticipate the claimed invention under the doctrine of inherency ***because there is no disclosure in Timm et al. that the DSL router 330 operates to assemble the upstream DSL signals into a single Ethernet signal for transmission as claimed.*** Further, there is no implication in the cited art that such functionality must necessarily occur. Col. 16, lines 9-11 of Timm et al. simply states that ***the DSL modem 330 acts as a router*** for the LAN 320. No

language in the reference indicates that it also performs any re-assembling of data, ***nor would such functionality be required or necessary.***

While the modem 330 could hypothetically split and re-assemble data frames from the modems 340, 342, and 344, it is unclear why this would be desirable. For example, if the modem 340 in Fig. 3b of Timm et al. constructed a packet with a header containing a destination address #1, while the modem 342 constructed another packet with a header containing a different destination address #2, the DSL modem 330, acting as a router, would not have any reason to split and re-assemble such data packets. Rather, the DSL modem 330, acting as a router as explicitly taught in Timm et al., would simply use the header destination addresses to route the packets to their respective, different destinations. Any disassembling performed by the DSL modem 330 would require a subsequent re-assembling as an interim point of receipt (resulting in undesirable delays associated therewith), as well as create inefficient routing if such destinations (dictated by the different destination addresses) were substantially disparate. That is, after re-assembling, one or both of such packets may need to be further re-routed as the destination address would not match. Consequently, not only would splitting and re-assembly of data frames by the modem 330 ***not necessarily occur, but such functionality would be undesirable to one of ordinary skill in the art.*** Clearly then, the DSL modem 330 does not ***inherently*** teach the claimed invention under the appropriate standard set forth by the Federal Circuit, and thus the cited art fails to anticipate the claimed invention.

Further, it was requested that if the Examiner chose to maintain the rejection of the pending claims in view of Timm et al., applicant respectfully requested a detailed explanation as to how and/or why the DSL modem 330 must ***necessarily operate*** to combine multiple DSL signals into a single Ethernet signal as claimed. Further, to the extent that the previous Office Action was taking Official Notice of an alleged fact, a request was made that an explanation and supporting documentation be provided including specific factual findings predicated on sound technical and scientific reasoning to support the conclusion, as required by MPEP §2144.03 (B), (C) (*citing* 37 C.F.R.

§1.104(c)(2) and In re Zurko, 258 F.3d 1386 (Fed. Cir. 2001)). Neither the final Office Action nor the Advisory Action provided the requisite showing. For at least this additional reason, withdrawal of the outstanding rejection is respectfully requested.

**II. CONCLUSION**

For at least the above reasons, the claims currently under consideration are believed to be in condition for allowance.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 50-1733, REIIP101USA.

Respectfully submitted,  
ESCHWEILER & ASSOCIATES, LLC

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